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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,788	11/29/2000	Chun Yuen To	WWSM 2473	1169

321 7590 04/24/2003

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 04/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/725,788

Applicant(s)

TO, CHUN YUEN

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 30 is/are allowed.
- 6) ☐ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. A new application data sheet has been submitted which acknowledges the filing of a foreign application. Claims 18-29 have been amended to overcome the previous 35 USC 251 claim rejection.

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. In Claim 7, it is not understood by what is meant by "upstanding". Which direction is up?
3. Claim 17 recites the limitation "the engagement member" in line 4. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies (5,158,387) in view of Schuessler (5,160,209).

Davies discloses in Fig. 1 and 3, a ring binder comprising: a rigid integral upper structure (21A), having a recess (21B) with which an upper end (22) of an engagement portion (22 and 30, seen in Fig. 3) is deformable to directly engage the upper structure (21, as seen in Fig. 3); a pivotable lower structure (A) supported by the upper structure (21A); ring members (21C) mounted to the lower structure (A); at least one integral securing means and fastener (30, 26, 32) for securing the ring binder (21) to a base member (15); wherein the securing means includes an upstanding engagement portion (22 and 30) which extends away from the base; a plurality of deformed upward depending securing elements (32) for securing the ring binder to the base member, and further having a right angled configuration (wherein the securing elements depend from a plate (31), which abuts the base member (in a recess, as seen in Fig. 3) and wherein the securing elements have free ends (D); wherein the longitudinal axis of the ring binder is transverse to the longitudinal axis of the engagement portion; and wherein the engagement portion can be integrally formed with the plate member (wherein portion 30 is integrally formed with the plate member as seen in Fig. 3), and further wherein the securing elements can be integrally formed with the plate member (Fig. 3).

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However, Davies does not disclose: a plurality of deformed downward depending securing elements having a arcuate configuration; wherein at least 75% of the elements extend away from a longitudinal axis of the engagement portion; wherein the securing elements have substantially the same length, positioned equidistantly, and wherein the ends lie in the same plane; and wherein the plate member is parallel to the longitudinal axis of the ring binder; free ends located at an end farthest from the engagement portion and are coplanar.

Schuessler discloses in Fig. 1, 2, 4-6, a securing fastener comprising: a plurality of deformed downward depending securing elements (62) having a arcuate configuration (Col. 7, lines 20-25); wherein the securing elements have substantially the same length (Col. 7, lines 23-27); wherein the plate member is parallel to the longitudinal axis of the ring binder (as seen in Fig. 1); and wherein free ends are located at an end farthest from the engagement portion (seen in Fig. 6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Davies' ring binder to include a securing fastener comprising a plurality of securing elements depending downward in an arcuate configuration and having a plate member, as taught by Schuessler for the purpose of providing an alternative means of connecting a ring binder to a cover member.

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However, Davies as modified by Schuessler does not disclose: wherein at least 75% of the securing elements extend away from a longitudinal axis of the engagement portion, positioned equidistantly, and wherein the ends lie in the same plane; and wherein the free ends are coplanar

In regards to **Claims 1-3, 13, 18, 19, 21, 21 and 29**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the securing elements to extend in any desirable planar direction and positioned at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to extend any percentage of the securing elements, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Allowable Subject Matter***

5. Claim 30 is allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly teaches a ring binder comprising: a substantially rigid integral

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upper structure; a pivotable lower structure supported by the upper structure; a plurality of ring member mounted to the lower structure; at least one integral securing fastener for securing the ring binder to the base; wherein the securing fastener includes an engagement portion in direct engagement with the upper structure for attaching the securing fastener to the upper structure, wherein the securing fastener is free from any intervening sleeve member between the fastener and the upper structure; and including all of the other limitations of the independent claim.

***Response to Arguments***

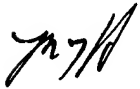
7. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection. The Davies reference now discloses an engagement portion in direct engagement with the upper structure.



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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

April 22, 2003



MONICA CARTER  
PATENT EXAMINER